

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES
(Attorney Docket No. 14305US02)

In the Application of:

Jeyhan Karaoguz, et al.

Serial No. 10/675,489

Filed: September 30, 2003

For: METHOD AND SYSTEM FOR
MEDIA EXCHANGE NETWORK
WITH SERVICE USER
INTERFACE

Examiner: Patrick A. Ryan

Group Art Unit: 2427

Confirmation No. 6006

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
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Sir:

This Reply Brief responds to the Examiner's Answer mailed November 2, 2010. For at least the reasons set forth in the Appeal Brief and this Reply Brief, the Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-34, 37-39, and 42-44 of the present application.

REMARKS

The Examiner's Answer states that "Applicant Serial Number (10/675,468) ... contains similar claimed subject matter to the instant application." The Applicants agree that Application No. 10/675,468 may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

The Examiner's Answer presents essentially the exact same arguments as the Final Office Action. *Compare* Examiner's Answer at pages 4-13 with March 2, 2010 Office Action at pages 4-12. As such, the Appeal Brief addresses these arguments at pages 7-11. To the extent that the Examiner's Answer provides any new arguments, the Applicants will address below.

I. Yen Does Not Anticipate Claims 1-32, 34, 37, 39, And 42

A. Claim 1 And The Claims That Depend Therefrom

Claim 1, for example, recites, in part, "**wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement.**"

Notably, the claim clearly differentiates between "receiving" and "viewing." Similar to a piece of mail, email, or the like, the announcement may be received. The user decides if and when the announcement is received. However, the act of receiving the announcement is not the same as a user actually viewing the announcement. For example, the user may decide that a particular announcement will be received. The announcement may then be received by a set top box, for example. The user then decides when to view the announcement. Again, the act of reception and the act of viewing are separate and distinct acts.

If the Applicants contemplated that the terms were synonymous, the Applicants would not have used different terminology within the same claim, as doing so would, for example, undermine the principle of claim differentiation. That is, if the Applicants contemplated that "receiving" and "viewing" were the same or similar act, the Applicants

would have used one consistent term, as opposed to two separate terms for the same or similar act.

Yet, the Examiner's Answer's argument depends on conflating "receiving" with "viewing." *See* Examiner's Answer at pages 14-15. In particular, "it is the Examiner's position that an act of **viewing** is within the scope of an act of **receiving**, such that Yen's teaching of "viewing the alerted item" also addresses an act of receiving an alerted item." *See id.* (emphasis added).

Such circular logic, however, completely violates the principle of claim differentiation. Moreover, this conflation of terms fails to consider the claim language in light of the specification.

"Receiving" and "viewing" are by no means synonymous, particularly in the context of the present application and the claims. Again, if the Applicants contemplated that the terms meant the same thing, the claims would not be drafted such that different terms are used. That is, if the Applicants contemplated that "receiving" meant "viewing," the Applicants would have drafted the claims so that they consistently recited "viewing." Instead, however, the claims and specification clearly differentiate between the terms.

The Applicants note that the "broadest construction rubric coupled with the term 'comprising' does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, **claims should always be read in light of the specification and teaching in the underlying patent.**" *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (emphasis added).

The attempt in the Examiner's Answer to conflate "receiving" with "viewing" leads to an unreasonable claim construction in that it violates the principle of claim differentiation, for example. Moreover, the attempt to conflate the terms fails to consider the claims in light of the specification.

As explained in the Appeal Brief, there simply is nothing in Yen that describes, teaches, or suggests "**wherein said user decides if and when said announcement**

should be received, wherein said user chooses when to view said announcement.”

Yen, by itself, does not disclose “each and every element as set forth in the claim.” See *Verdegaal Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053. Yen does not show the “**identical** invention … in as completed detail as contained … in the claim.” See *Richardson*, 868 F.2d at 1226, 9 USPQ2d at 1920 (emphasis added). Thus, for at least the reasons set forth in the Appeal Brief and above, Yen does not anticipate claim 1 or any of the claims depending therefrom.

B. Claim 11 And The Claims That Depend Therefrom

Claim 11 recites, in part, “wherein said **user decides if and when** said announcement should be received, wherein said **user chooses when to view said announcement.**” As explained above, Yen does not describe, teach, or suggest all of these limitations. Thus, for at least the reasons discussed in the Appeal Brief and above, Yen does not anticipate claim 11 or the claims that depend therefrom.

C. Claim 21 And The Claims That Depend Therefrom

Claim 21 recites, in part, “wherein said **user decides if and when** said announcement should be received, wherein said **user chooses when to view said announcement.**” As explained above, Yen does not describe, teach, or suggest all of these limitations. Thus, for at least the reasons discussed in the Appeal Brief and above, Yen does not anticipate claim 21 or the claims that depend therefrom.

II. The Proposed Combination Of Yen And Trajkovic Does Not Render Claims 33, 38, And 43 Unpatentable

The Applicants now turn to the rejection of claims 33, 38, and 43 as being unpatentable over Yen in view of Trajkovic. For at least the reasons discussed in the Appeal Brief and above with respect to claims 1, 11, and 21, the Applicants respectfully submit that the proposed combination of Yen and Trajkovic does not render claims 33, 38, and 43 unpatentable.

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III. CONCLUSION

The Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-34, 37-39, and 42-44.

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

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